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13  
14 UNITED STATES DISTRICT COURT  
15  
16 NORTHERN DISTRICT OF CALIFORNIA  
17  
18 SAN FRANCISCO DIVISION

19 ORACLE AMERICA, INC.,

20 Plaintiff,

21 v.

22 GOOGLE INC.,

23 Defendant.

24 Case No. 3:10-cv-03561-WHA

25 **GOOGLE'S OPPOSITION TO  
26 ORACLE'S MOTION IN LIMINE NO. 4  
27 TO EXCLUDE EVIDENCE OR  
28 ARGUMENT REGARDING ORACLE'S  
PAST ACTIONS WITH APPLICATION  
PROGRAMMING INTERFACES**

29 Judge: Hon. William Alsup

30 Date Comp. Filed: October 27, 2010

31 Trial Date: October 31, 2011

## I. Introduction

2 Oracle seeks to exclude obviously relevant, probative evidence that its predecessor Sun  
3 Microsystems repeatedly and publicly declared that application programming interfaces  
4 (“APIs”), such as the ones associated with its Java programming language, were not  
5 copyrightable as a matter of law. As with so many other positions long advocated by Sun,  
6 Oracle now wants to take a more restrictive view, but the fact remains that Sun was right—and  
7 that Google (and numerous other companies) relied on its repeated pronouncements in using the  
8 APIs at issue in this case. When Oracle acquired Sun, it not only bought Sun’s valuable  
9 intellectual property, it also took on Sun’s prior commitments and assurances about the scope of  
10 its intellectual property rights. Oracle argues that admitting evidence of Sun’s statements would  
11 confuse the jury, but in reality Oracle is worried that those statements would reveal its thin and  
12 unprecedented copyright case for what it is—an eleventh-hour reversal purely for litigation  
13 purposes.

14 For more than a decade, Sun was a leader in promoting open systems and architectures  
15 and interoperability. Both directly and through the American Committee of Interoperable  
16 Systems (“ACIS”—the leading advocacy group for interoperability that Sun formed, ran and  
17 housed in its corporate headquarters in Mountain View—unambiguously articulated the position  
18 in public statements, sponsored academic publications, numerous *amici* filings in software  
19 infringement cases, and testimony before Congress that APIs such as the ones at issue in this  
20 case are not entitled to copyright protection. Rather, Sun’s position was always that copyright  
21 protection extends to underlying code, but not to non-literal, functional elements such as APIs.  
22 In reliance on more than a decade of widely publicized statements by Sun and ACIS, Google and  
23 the Open Handset Alliance created Android, a new and original platform, to be interoperable  
24 with Java language APIs. Consistent with its public stance, Sun applauded Google’s efforts; its  
25 then-CEO announced that Android would be a “set of rockets” boosting Java’s momentum into  
26 the future. Then Oracle acquired Sun and sued Google for doing exactly what Sun represented  
27 for years was permissible (and indeed what Oracle, by its own conduct, seemed to view as  
28 permissible before doing a 360 degree turn and filing this lawsuit).

1        By its motion *in limine*, Oracle seeks to keep from the jury highly probative and material  
 2 evidence of Sun's words and deeds going back to the early 1990s (and continuing through the  
 3 launch of Android) and by the actual practices of both Sun and Oracle in implementing third  
 4 party APIs in their own products. There is no basis for Oracle's request. This evidence directly  
 5 shows that Google had a reasonable and justified belief that, as long as it did not copy Sun's  
 6 Java-language code, it could implement Java language APIs. All these facts directly support  
 7 Google's defenses of estoppel, waiver and implied license, which in turn bar Oracle's attempt to  
 8 reap huge windfall profits from Google's reliance on its and Sun's statements and practices.

9        **A. Evidence of Sun and Oracle's past practices of implementing third-party APIs and  
 10 public statements that APIs are not copyrightable are relevant and material to  
 Google's defenses.**

11        The materials that Oracle seeks to shield from the jury at trial fall into two categories: (1)  
 12 examples of Sun and Oracle's practice of "copying" APIs from third parties; and (2) public  
 13 statements by Sun executives on the copyrightability of APIs. Oracle argues that Sun and  
 14 Oracle's own use of third party APIs, and statements by Sun and Oracle employees about  
 15 permissible uses of APIs, are not relevant. Oracle is wrong. Sun's and Oracle's words and  
 16 deeds with respect to APIs could not be more relevant to—and, indeed, tend to prove as a matter  
 17 of law—Google's defenses of estoppel, waiver and implied license.

18        First, to prevail on its defense of estoppel, Google must establish reasonable reliance.  
 19 *See, e.g., Field v. Google, Inc.*, 412 F. Supp. 2d 1106, 1115 (D. Nev. 2006). The most direct and  
 20 sensible way for Google to meet this burden is by introducing evidence of Sun's and Oracle's  
 21 own assurances regarding the copyrightability of APIs, their intent to enforce purported  
 22 copyrights on APIs, and their practices regarding copying the sort of APIs that are now asserted  
 23 in this case to be protected.

24        Second, to establish waiver, Google must demonstrate that through its past actions or the  
 25 actions of its predecessor-in-interest Sun, Oracle relinquished or surrendered rights. *United*  
 26 *States v. King Features Entertainment, Inc.*, 843 F.2d 394, 399 (9th Cir. 1988). Again, Google is  
 27 entitled to introduce evidence of Sun's public statements that were designed to, and did, assure  
 28 anyone who might be listening that it could not and would not assert copyrights in APIs, and by

1 the actual practices of both Sun and Oracle that are inconsistent with the position Oracle now  
 2 takes.

3 Third, Google's implied-license defense requires proof that Oracle engaged in conduct  
 4 from which a license might reasonably be implied. *See Effects Assocs. v. Cohen*, 908 F.2d 555,  
 5 558 (9th Cir. 1990), *cert. denied*, 498 U.S. 1103 (1991) (holding that an implied license may be  
 6 granted orally or by implication based on the parties' conduct). Once again, Google intends to  
 7 make this showing by introducing evidence of the practices of both Sun and Oracle and Sun's  
 8 public pronouncements. Google is entitled to make this showing by introducing evidence of the  
 9 practices of both Sun and Oracle and Sun's public pronouncements.

10 It is no wonder that Oracle wants to preclude this critical evidence, because there is just  
 11 so much of it. For over a decade prior to the filing of this case, both Sun and Oracle  
 12 communicated the clear message that Android (or anyone) could use Java language APIs for any  
 13 purpose. As far back as 1994, Sun testified to Congress that while underlying code is entitled to  
 14 copyright protection, APIs are not. Dkt. No. 263-7, Prepared Testimony of Dr. Eric Schmidt,  
 15 Chief Technical Office, Sun Microsystems, Inc., Before the Senate Judiciary Committee,  
 16 Antitrust, Technology and Law Subcommittee, Sep. 20, 1994 ("Schmidt Testimony"). Over the  
 17 following decade, ACIS, which Sun created and was run by a senior member of its legal  
 18 department (Deputy General Counsel Peter M.C. Choy) from Sun's Mountain View  
 19 headquarters, communicated in *amicus* filings and in sponsored academic papers that copyright  
 20 law could not and should not thwart interoperability between computer languages, platforms,  
 21 operating systems and platforms (consistent with Sun's business objectives). *See, e.g.*, Mullen  
 22 Decl. Ex. 6 (ACIS Fact Sheet) *available at* <http://www.interop.org/fact-sheet.html>. Indeed, the  
 23 very purpose of ACIS was to organize support for the proposition that APIs were not protectable  
 24 by copyright, as evidenced in its organizational principle that "[t]he rules or specifications  
 25 according to which data must be organized in order to communicate with another program or  
 26 computer, i.e., interfaces and access protocols, are not protectable expression under copyright  
 27 law."

28

1       While the statements may refer to APIs generally, rather than Java-specific APIs, Oracle  
 2 is wrong to suggest that those statements were limited to existing or specific APIs. Rather, they  
 3 were broad and intended to generally state Sun's position about the open and unprotected nature  
 4 of *all* APIs. *See, e.g.*, Schmidt Testimony. The jury reasonably could interpret this information  
 5 to support the proposition that Sun's publicly stated policy was that *all* APIs were unprotected by  
 6 copyright.

7       The evidence that Oracle seeks to exclude will also show that Sun put its money where its  
 8 mouth was, transforming its publicly articulated policies into development practices. Most  
 9 probative is both Sun's and Oracle's practices of implementing third party APIs. For example,  
 10 as Prof. Astrachan's expert report shows, Sun's Solaris operating system "copied" APIs from the  
 11 Linux operating system. (Owen Astrachan Opening Report, Dkt. . No. 262-1, p. 39). Sun's  
 12 stated purpose for using the APIs was to increase compatibility. *See* Mullen Decl. Ex. 7,  
 13 available at [http://www.sun.com/software/solaris/9/sparc/solaris9\\_features\\_compatibility.xml](http://www.sun.com/software/solaris/9/sparc/solaris9_features_compatibility.xml)  
 14 ("Sun has built many features into the Solaris OS to make it compatible with Linux, including  
 15 APIs"). In other words, Sun engaged in exactly the same conduct—consistent with its public  
 16 pronouncements about APIs and interoperability—for which Oracle is now suing Google. That  
 17 is as direct support for Google's defenses of estoppel, waiver and implied license as can be  
 18 imagined.

19       Indeed, Sun referenced its API implementations in marketing materials for Solaris,  
 20 further communicating and reinforcing Sun's stated public position on API compatibility. *See*  
 21 Mullen Decl. Ex. 8, *e.g.*, [http://www.oracle.com/us/products/servers-  
 22 storage/solaris/interoperability-solaris-10-ds067316.pdf](http://www.oracle.com/us/products/servers-storage/solaris/interoperability-solaris-10-ds067316.pdf) ("As Linux interfaces continue to  
 23 evolve, Oracle Solaris maintains source-level compatibility . . ."). Similarly, as documented by  
 24 Dr. Astrachan, other Sun and Oracle products (StarOffice and Oracle Database Server,  
 25 respectively<sup>1</sup>) copy APIs originally developed by others. This behavior was entirely consistent  
 26 with Sun's public communications on the subject of API compatibility and industry practice.

27  
 28 <sup>1</sup>Sun's StarOffice and OpenOffice product have the same APIs as earlier spreadsheet programs,  
 and Oracle's flagship database is based on APIs authored by IBM. *See, e.g.*, Owen Astrachan

1 For all these reasons, this evidence is plainly relevant to Google's defenses and should be  
 2 heard by the jury.

3 **B. Evidence of Sun and Oracle's past practices and statements and dramatic change of  
 4 position are neither prejudicial nor confusing.**

5 Oracle asserts that its past words and deeds with respect to APIs would be confusing to  
 6 the jury, and therefore must be excluded under Federal Rule of Evidence 403. But there is  
 7 nothing confusing about any of this. If anything, Oracle's turnabout will be the easiest thing for  
 8 the jury to grasp in this highly technical case. Evidence that a litigant changed a long-held and  
 9 followed position out of expedience and a desire to obtain a lucrative verdict is frankly much  
 10 easier for a jury to grasp than the multiple technical claims and specifications that Oracle intends  
 11 to put into evidence in support of its affirmative claims

12 Oracle raises three points in support of its argument that the risk of confusion outweighs  
 13 its probative value under Fed. R. Evid. 403: (1) that Sun and Oracle's past copying of APIs and  
 14 public statements represent bad acts, which would prejudice the jury; (2) that this evidence  
 15 would complicate the trial; and (3) that Sun's pronouncements are statements of law that would  
 16 confuse the jury. None of these arguments is availing.

17 First, Google is not arguing that Sun or Oracle engaged in misconduct by copying APIs.  
 18 The entire point is that there is nothing wrong with copying APIs, because APIs are not entitled  
 19 to copyright protection and are essential to interoperability. This policy supported and informed  
 20 Sun's behavior when various third parties prior to Google implemented Java language APIs  
 21 without objection from Sun. In fact, this information should reduce confusion, by providing a  
 22 broader context of corporate policy that will help support and explain specific Java-related  
 23 evidence that Oracle has not challenged, such as Mr. Schwartz's blog posts praising (rather than  
 24 threatening to sue) Google for launching Android.

25 Second, this evidence would hardly complicate the trial is meritless. Again, this is basic,  
 26 straightforward factual evidence of Sun and Oracle's statements and conduct. In comparison to

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27 Opening Report, Dkt. No. 262-1, p. 36, 44.  
 28

1 the highly-technical testimony that the jury will have to review, this is as clear as an eyewitness  
 2 testifying that the light was green. Moreover, Rule 403 does not permit exclusion of evidence  
 3 that “will it complicate the trial”; it requires undue delay that “substantially outweighs” the  
 4 probative value. The amount of evidence involved is small and it will not take long to present or  
 5 require the presence of additional witnesses beyond those already testifying. By contrast, the  
 6 probative value of the evidence to Google’s defenses is massive.

7       Third, Oracle is wrong to argue that some of the potential evidence consists of statements  
 8 of law. Whatever Sun’s amicus briefs might have advocated about the state of the law, Google  
 9 intends to use those briefs to show what Sun’s official policy was, not what the law is or should  
 10 be. The court can easily explain to the jury that this evidence relates to Sun’s and Oracle’s belief  
 11 and actions and Google’s reliance only, and separately instruct the jury about the correct legal  
 12 standard to apply to Oracle’s substantive copyright claims.<sup>2</sup>

## 13           II.     Conclusion

14       Sun’s public pronouncements over many years, and both Sun’s and Oracle’s practices of  
 15 copying third party APIs, directly establish Google’s defenses of estoppel, waiver and implied  
 16 license. The probative value of this evidence is tremendous, and it is not prejudicial in any  
 17 legally meaningful sense. Oracle may not cry “prejudice” just because this material hurts its  
 18 case. There is no basis for excluding any of it from trial.

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22       <sup>2</sup> Finally, none of the cases Oracle cites support its conclusion. The unpublished  
 23 case Oracle cites on the issue of evidence used to show misconduct, *Leegin Creative Leather*  
*Prods. v. Belts by Nadim, Inc.*, 316 Fed. Appx. 573, 575 (9th Cir. 2009), contains no discussion  
 24 of why the evidence at issue was excluded. It merely affirms exclusion of prior bad acts  
 evidence. As noted in this Opposition, however, Google is not seeking to introduce evidence of  
 prior bad acts.

25       *Hodge v. Mayer Unified Sch. Dist. No. 43 Governing Bd.*, 2007 U.S. App. LEXIS 8595  
 26 (9th Cir. 2007), a bad acts case, and *Santrayll v. Burrell*, 1998 U.S. Dist. LEXIS 586 (S.D.N.Y.  
 27 Jan. 22, 1998), relating to material used for impeachment, similarly are not on point.

28       *A & M Records, Inc. v. Napster, Inc.*, 2000 U.S. Dist. LEXIS 20668 (N.D. Cal. Aug. 10,  
 2000), addresses whether an expert may offer opinions on the applicable law, an issue wholly  
 unrelated to the one at bar. Google seeks to introduce the challenged evidence not because it  
 supports Google’s legal position in this case but because it shows that Sun’s official position was  
 that APIs are uncopyrightable, which is highly probative of estoppel, waiver and implied license.

1 Dated: October 4, 2011

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